REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following

remarks are respectfully requested. Claim 1 is amended without prejudice or disclaimer.

Rejection of Claims 39-54 Under 35 U.S.C. §103(a)

The Office Action rejects claims 39-54 under 35 U.S.C. §103(a) as being unpatentable

over Beach et al. (U.S. Patent No. 6,728,713) ("Beach et al.") in view of Greer et al. (U.S. Patent

No. 5,978,828) ("Greer et al."). Applicants respectfully traverse this rejection and submit that

first one of skill in the art would not have sufficient motivation or suggestion to combine these

references and secondly, even if combined, Applicants submit that these references fail to teach

each limitation of the claims. We first turn to the issue of whether one of ordinary skill in the art

would have sufficient motivation or suggestion to combine these references.

As set forth in MPEP 2141, when considering obviousness of a combination of known

elements, the operative question is "whether the improvement is more than the predictable use of

prior art elements according to their established functions." KSR 550 US, 82 USPQ 2d 1385,

1396 (2007). We also note that the Court recognized that when a patent claims a structure

already known in the prior art that is altered by the mere substitution of element for another

known in the field, the combination must do more than yield predictable results. We note that

these and other principles set forth in the MPEP are applicable to the analysis at hand.

We also note that MPEP 2141.02, Section VI requires that the prior art reference must be

considered in its entirety, i.e., as a whole, including portions that would lead away from the

claimed invention. This should be applicable as shall be set forth below as we analyze the

particular teachings of each reference. We also note that MPEP 2141.01, Section II teaches that

the test for obviousness is what the combined teachings of the references would have suggested

to one of ordinary skill in the art, and all the teachings of the prior art must be considered to the

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extent that they are in analogous arts. With the teachings of two or more prior references

conflict, the Examiner must weight the power of each reference to suggest solutions to one of

ordinary skill in the art, considering the degree to which one reference might accurately discredit

another. We shall explain also below why this principle is applicable in the present case

inasmuch as one of the references expressly distances and criticizes the teachings that the Office

Action asserts should be incorporated into the primary reference.

Several other MPEP sections are also applicable. MPEP 2143.01, Section V teaches that

"if the proposed modification would render the prior art invention being modified

unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the

proposed modification." This principle would also be applicable in the analysis set forth below

inasmuch as the suggested blending of these references would require the primary reference to be

unsatisfactory for its stated and intended purpose. Finally, Section VI of this portion of the

MPEP states that "if the proposed modification or combination of prior art would change the

principle of operation of the prior art invention being modified, then the teachings of the

reference that are not sufficient to render the claims prima facie obvious." Again, Applicants

shall explain why this would be the case if these references were blended.

We now turn to the teachings of the references. We first note that Beach et al. focus on a

distributed database management system that provides a centralized database resident on a

servicer that contains database objects. They explain in the Abstract that objects to be replicated

are gathered together in distributed packages called "slices" that are encrypted using a short-

lived symmetric key and broken into a succession of short, numbered data packets before being

transmitted to client devices. Figure 1 illustrates the basic distributed television viewing .

management system. Of primary importance with regards to the present analysis, we note that

Beach et al., in column 1, lines 10-15, teach that their invention relates to storing and the viewing

of television program material in a compute environment. They note in their description of the

prior art, that starting at column 1, line 61, that "television viewing may be modeled as a client-

server system, but one where the server-to-client network path is for all intents and purposes of

infinite speed, and where the client-to-server path is incoherent and unmanaged. This is a natural

artifact of the broadcast nature of television. The cost of adding another viewer is zero, and the

service delivered is the same as that delivered to all other viewers." Applicants note that in

column 2 of Beach et al. begins that

> "there have been, and continue to be, many efforts to deliver television programming
> over computer networks, such as the Internet, or even over a local cable television plant
> operating as a network. The point-to-point nature of computer networks makes these
> efforts unwieldy and expensive, since additional resources are required for each
> additional viewer. Fully interactive television systems, where the viewer totally controls
> video streaming bandwidth through a client settop device, have proven even more
> uneconomical because dedication of server resources to each client quickly limits the size
> of the system that can be profitably built and managed." (Emphasis added.)

Applicants basic point here is that the concept of point-to-point communication such as in

computer networks over the Internet is expressly criticized by Beach et al. This is important

with regards to the analysis of whether it would be obvious to combine these teachings with

Greer et al. which we shall discuss in a moment.

Returning to the basic teachings of Greer et al., we note that what is taught is a broadcast

television distribution network as is shown in Figure 1 with broadcast transmission 108 as well

as a computer based communication system using a connection based transmission 109 which is

in a server-to-client context. In this case, what is communicated via the physical connection are

these objects that are gathered together into distribution packages called "slices". A slice is

defined as a subset of a central database which is relevant to clients with a specific domain, such

as a geographic region, or under the footprint of a satellite transmitter. See column 2, lines 37-

43. They explain in line 55 that a slice is transmitted by breaking the encrypted slice into a

succession of short, numbered data packets, each slice is encrypted using a short-lived symmetric

key before being transmitted to client devices. When a connection between the central database

and a client device, the client device sends an inventory of previously received slices to a

transmission server. The transmission server compares the inventory with the list of slices that

should have been processed by the client. Slices which are not processed are then transmitted to

the client. Thus, the concepts that are disclosed in Beach et al. relate to these objects or slices

which are communicated via communication link 109 as shown in Figure 1 but which are always

taught as being separate from the television content. For example, column 5, lines 37-51, discuss

the "fundamental object types defined by the invention." These include such things as program

schema which may include attributes such as a producer, the director or actors of the program, an

on-screen icon, a multi-line description of the program contents, an editorial rating of the

program, and so forth. There is no teaching that the information in the slices or of the

fundamental object types include program content. Column 10, lines 18-23, also teach "for

efficiency, objects to be replicated are gather in together into distribution packages, herein called

'slices'. A slice is a subset of the television viewing object database which is relevant to client

within a specific domain, such as a geographic region, or under the footprint of a satellite

transmitter."

Thus, Applicants respectfully transmit that when the Examiner cites columns 6, 7 and 15,

that the concepts that are disclosed in there do not relate to a mechanism by which these slices

may be communicated via connection 109 to a client device separate from the content that is

delivered via a standard television broadcast. In another case, the slices may be sent or

modulated into lines of the vertical blinking interval (VBI) of the standard television broadcast

108 or added to the digital television multiplex signal as a private data channel. See column 11,

lines 14-23. In any event, Applicants note that the use of these slices is clearly articulated as

being separate from the broadcast television source. This of course must be the case inasmuch as

the introduction to the invention of Beach et al. expressly criticizes the point-to-point nature of

computer networks with regards to delivering television programming per se.·

Now, Applicants note with this introduction and discussion of the suggestive power and

intended purpose of Beech et al., we now turn to Greer et al. and note that the Office Action

asserts that it would be obvious of one of ordinary skill in the art at the time of the invention to

combine the teachings of Beach et al. with Greer et al. for the purpose of determining that stored

data is old or out of date by comparing latest update times and time stamps. Time stamping and

maintaining the date and time of content modifications are common techniques used in the art for

effectively implementing updates, as is asserted in the Office Action. Applicants submit that the

portions of Greer et al. that are cited include columns 3-9 in which there is much discussion

regarding webpage control records. In each of these cited portions, the concept of modifying

web pages and updating web pages is taught. Applicants note that the Abstract of Greer et al.

explain that their invention is a method of providing notification of a <u>content</u> change of a web

page. The method includes transmitting a request from a first electronic system to a second

electronic system for a quotient value indicative to the content change and transmitting the

quotient value from the second electronic system to the first electronic system, and comparing

the quotient value to a predetermined value to determine whether a threshold is triggered.

Applicants note that the discussion with regards to whether the content that is changed in

Greer et al. is the primary content of the webpage or some other content (which may be

comparable to the slices in Beach et al.) reveals that what is clearly taught in Greer et al. is that it

is the <u>content</u> of web pages themselves that have changed and not some other kind of metadata or

secondary information as in the slices. See column 1, lines 30-35. Thus, Applicants submit that

it is clear that it is the primary content within a web page that may have changed which is the

subject of the invention of Greer et al. Applicants note that in one respect, we would submit that

Greer et al., with regards to how they primarily deliver content to a user, is non-analogous to

Beach et al. This is because Beach et al. require their television program to be delivered via a

broadcast mechanism rather than via the point-to-point nature of the Internet as is taught in Greer

et al. Therefore, Applicants respectfully submit that if the teachings of Greer et al. were to be

incorporated into the teachings of Beach et al., it would necessarily render Beach et al.

unsatisfactory for its intended purpose because it would require the delivery of the programming

content to be done via web pages and URLs, which mechanism is expressly criticized as being

"unwieldy and expensive" as well as "uneconomical" in column 2 of Beach et al. Beach et al.

set forth their invention, which maintains the broadcast nature of television while allowing for

the secondary information to be provided via distribution packages called slices in response to

the problems of delivering content over the Internet. Applicants submit that one of skill in the

art, when viewing the suggestive power of each of these references, would recognize that the

fundamental teachings of Greer et al. is that content is to be delivered by a web page via the

Internet, and that the primary or programming content of Beach et al. is expressly not to be

delivered via the Internet. This is one reason why several portions of the MPEP would lead one

of skill in the art to a conclusion that there is insufficient motivation or suggestion to make the

proposed modification in the Office Action.

Furthermore, MPEP 2143.01, Section VI, teaches that if the proposed combination of the

prior art would change the principle of operation of the prior art invention being modified, then

the teachings of the reference are not sufficient to render the claims prima facie obvious.

Applicants again submit that this is the case inasmuch as it is the mechanism by which the

content is delivered that differs in Greer et al. and Beach et al. that would require the change in

the principle of operation of Beach et al. to cause these references to be blended. Applicants

note that while a focus on the claims is not a primary element of whether one of skill in the art

would combine these references, the express requirement in the claims, for example claim 39, is detecting a need for the "performance content" by determining whether stored performance content is out of date. Applicants therefore respectfully submit that because the claims focus on performance content, which if one were to compare to Beach et al. would necessarily lead to the information that is delivered via a broadcast television source, that Applicants submit that the focus on the mechanism by which performance content is delivered necessarily leads to a conclusion that these references are either non-analogous or that blending them would violate several of the legal principles set forth in the MPEP.

Applicants further note that the blending of these references also fails under a KSR analysis. Blending these references is not merely the substitution of one known prior art element by another to do more than yield a predictable result. In other words, because there is an express teaching away from the blending of such references, i.e., by teaching away from the idea of utilizing the Internet to deliver performance content, Applicants submit that this certainly involves a change in the fundamental principle of operation. Therefore, the present analysis is not applicable to the idea of taking known structures and altering one by the mere substitution of one element for another. Therefore, this combination does not simply yield a predictable result as was the case in KSR.

Furthermore, we note that the analysis above supports our position that the answer to the operative question of whether the improvement is more than the predictable use of prior art elements according to their established elements according to their established functions clearly does not apply. In other words, because there would be a requirement of changing the principle of operation of Beach et al. to incorporate the teachings of Greer et al., then this is not simply the predictable use of prior art elements "according to their established functions" because the established functions of Beach et al. would fundamentally have to be altered in order to

incorporate the teachings of Greer et al. Therefore, under a <u>KSR</u> analysis, again, these references should not be combined.

Applicants further note that even if these references are combined they fail to teach each limitation of the claims. Applicants maintain this position because all of the use of "objects" and "slices" that are taught in Beach et al. do not constitute the "performance content". In other words, in each instance in which Beach et al. teach dealing with out of date information, it is with reference to delivering these distribution packages called "slices". Because Beach et al. teach and require that television content be delivered via a broadcast television source, in every instance cited in the Office Action, with regards to out of date information, the information relates to these slices and not to the performance content. Therefore, Applicants respectfully submit that even if combined, the discussions in column 6, column 7 and columns 12-16, do not teach anything regarding detecting a need for the <u>performance content</u> by determining whether stored performance content is out of date, selecting a process for obtaining the needed performance content, executing the process for obtaining the needed performance content and generating a pseudo-live performance by mixing content corresponding to one or more portions of the needed performance content with other content, wherein determining whether the stored program content is out of date further comprises the steps set forth in claim 39.

Applicants submit that the scope of the teachings of Beach et al. is that the performance content is only delivered by a broadcast mechanism and at the separate slice information, which as noted above is not the performance content itself but is rather content such as producer information, director or actors in the program, on-screen icons, multi-line descriptions of the program contents and so forth (column 5, lines 45-51), Applicants submit that the reference fails to teach each limitation of the claims, even if the claims were combined. Therefore, Applicants

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respectfully submit that claim 39 and dependent claims 40-45 are patentable and in condition for allowance.

Applicants submit that based on the analysis set forth above, the claim 46 and dependent claims 47-54 are also patentable and in condition for allowance.

Applicants finally note that the standard of proof in the present case is only by a preponderance of the evidence. In other words, if the preponderance of the evidence is in Applicants' favor with regards to whether one of skill in the art would have sufficient motivation or suggestion to combine these references, then the conclusion must be that these references should not be combined and the claims are patentable. Applicants submit that given the express teachings of Beach et al. with regards to the problems associated with delivering performance content via the Internet in a point-to-point communication mechanism, Applicants submit that we clearly have a preponderance of the evidence in our favor and therefore these claims are patent and in condition for allowance.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the

subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce &**

Quigg, LLP, Account No. 14-1437 for any deficiency or overpayment.

Respectfully submitted,

Date: November 3, 2008   By: _____

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